

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

REMARKS

Claims 2-5, 7-10, 12-13, 15-18 and 21-25 have been amended, and Claims 1, 14, 19-20 and 26-27 have been canceled. Claims 2-13, 15-18, and 21-25 are currently pending in the application. Applicants have previously paid filing fees in an amount sufficient to cover all of the claims that are now pending, and thus no additional filing fee is due in association with the submission of this Amendment. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

Objection to Claim 17

The Office Action objected to dependent Claim 17, due to a grammatical problem. The foregoing amendments correct this grammatical problem, in particular by implementing a change proposed by the Examiner.

Prior Restriction Requirement

Applicants' last two Responses each traversed a restriction requirement set forth in a prior Office Action mailed on February 3, 2005. In the first paragraph on page 2, the present Office Action states that the traverse is not found persuasive. However, Applicants continue to traverse the restriction requirement, and wish to clarify the reasons underlying the traverse.

To avoid confusion in the following discussion, it should initially be noted that the originally-filed claims inadvertently included two claims that were each numbered as Claim 25. The present Office Action indicates on pages 3-4 that the Examiner has renumbered the second original Claim 25 and also original Claim 26, such that these two claims are respectively now Claims 26 and 27. However, the prior Office Action did not allow for the claim numbering problem in setting forth the restriction requirement. All references to Claim 25 in the restriction requirement are references to the second original Claim 25 (which is now renumbered Claim 26), and all references to Claim 26 are references to what is now renumbered Claim 27. The

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

restriction requirement has no references to the first original Claim 25 (which is now the only Claim 25). Consequently, the restriction requirement was *inherently defective*, in that it forced Applicants to elect between several options, none of which provided for examination of the first original Claim 25. The Examiner is not entitled to impose a restriction requirement that is structured so one or more claims cannot possibly be elected, no matter what election is made. It is respectfully submitted that, in view of this defect, the restriction requirement must be withdrawn, and notice to that effect is respectfully requested. If the Examiner wishes to maintain a restriction requirement in the present application, the Examiner would need to issue a new office action setting forth a valid restriction requirement that takes all claims into account.

The present Office Action withdraws Claim 25 from examination on the theory that it is a non-elected claim, but this is not actually proper. In particular, the first original Claim 25 was not listed in any of the four claim groups in the restriction requirement. And since Claim 25 was not included in the restriction requirement, it is not one of the claims that Applicants chose not to elect. Consequently, Claim 25 is not one of the non-elected claims, and therefore was entitled to be examined on the merits. To the extent that the present Office Action fails to examine Claim 25 on the merits, it is respectfully submitted that the present Office Action is incomplete, and must be withdrawn and replaced with a proper and complete Office Action.

There is a further problem with the restriction requirement. More specifically, the prior Office Action indicates at lines 5-6 on page 2 that Claims 20-24 are drawn to a method of making a semiconductor device, classified in class 438, subclass 597. Then, in lines 3-4 on page 3, the prior Office Action makes the inconsistent assertion that these same claims (Claims 20-24) are actually drawn to a different invention, which is a method of planarizing topographic features on a substrate, classified in class 438, subclass 1+. In this regard, page 3 is attempting to assert that Claims 20-24 (Group IV) are patentably distinct from several claims in subclass 597 (Group III), on the theory that Claims 20-24 "have acquired a separate status in the art" because they are classified in subclass 1+ rather than subclass 597. However, this makes no sense in view of the fact that page 2 of the same Office Action expressly states that Claims 20-24

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

are in fact in subclass 597. In association with a traverse, Applicants elected Group III, which encompasses claims that are drawn to a method of making a semiconductor device classified in class 438, subclass 597. Since the prior Office Action admits at lines 5-6 on page 2 that Claims 20-24 are drawn to a method of making a semiconductor device classified in class 438, subclass 597, Claims 20-24 fall squarely within the subject matter that Applicants elected for examination. There is thus no reasonable basis for the Examiner to refuse to examine Claims 20-24. Stated differently, since the Examiner is already searching class 438, subclass 597 based on Applicant's election of Group III, there is little or no additional burden on the Examiner to also examine Claims 20-24, which the prior Office Action has admitted fall within this same class and subclass. And it is well-established PTO policy that examiners should not impose a restriction requirement as to any claim if that claim can be examined along with elected claims without any significant additional burden on the examiner. The foregoing amendments cancel Claim 20, but Claims 21-24 are still pending, and it is believed that they are entitled to be examined on the merits.

For the foregoing reasons, it is respectfully submitted that the restriction requirement is defective and must be withdrawn. Further, it is respectfully submitted that the present Office Action is incomplete and must be withdrawn. Moreover, it is respectfully submitted that there is no valid reason for Claims 21-24 to be treated as withdrawn claims, because the restriction requirement itself indicates that these claims fall squarely within the very class and subclass that Applicants elected for examination.

Claims 15-17

The Office Action rejected Claims 15-17 under 35 U.S.C. §103 as obvious over Chang U.S. Patent No. 6,855,602, taken in view of Quek U.S. Patent No. 6,136,710. This rejection is respectfully traversed, because the Chang patent is not prior art under §103 with respect to the present application.

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

In more detail, the Chang patent and the present application have a common inventor (Chia-Shiung Tsai). The Chang patent is assigned of record to Taiwan Semiconductor Manufacturing Co, Ltd. (reel 013921, frame 0296). The present application is also assigned of record to Taiwan Semiconductor Manufacturing Co, Ltd. (reel 014862, frame 0086). The present application and the Chang application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity (i.e. Taiwan Semiconductor Manufacturing Co, Ltd.). The Chang application issued as U.S. Patent No. 6,855,602 on February 15, 2005, and the face of the '602 patent reflects the fact that the '602 patent has the same owner as the present application (Taiwan Semiconductor Manufacturing Co, Ltd.)

The present application was filed after November 29, 1999, in particular on December 3, 2003. The Chang application was first published on September 30, 2004 (after filing of the present application), and later issued as a patent (also after filing of the present application). The Chang patent issued from an application filed on March 27, 2003 (before filing of the present application). Under 35 U.S.C. §102 (as opposed to §103), Chang would apparently not qualify as prior art, except possibly under §§102(e), 102(f) and/or 102(g). Consequently, as explained in MPEP §§706.02(k) and (l), Chang is not prior art under §103 with respect to the present application (regardless of whether or not Chang may possibly qualify as prior art under §102). Therefore, since the rejections of Claims 15-17 in the present Office Action are §103 rejections that are based in part on the Chang patent (which does not qualify as prior art under §103), it is respectfully submitted that the §103 rejections of Claims 15-17 are all defective and must be withdrawn.

Claims 15 and 17 each depended from Claims 1 and 14. The foregoing amendments introduce the limitations of Claims 1 and 14 into each of Claims 15 and 17, in order to convert Claims 15 and 17 into independent form. These amendments do not change the scope of Claim 15 or Claim 17 in any way. Accordingly, and since Claims 15 and 17 are not subject to any valid ground of rejection in view of the art of record, it is respectfully submitted that Claims 15 and 17 are now both in proper condition for allowance. Notice to that effect is

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

respectfully requested. In addition, the foregoing amendments modify Claim 16 so that it depends from Claim 15. Claim 16 should therefore also be in proper condition for allowance.

Claims 2-13 and 18

The foregoing amendments adjust the dependency of Claims 2-13 and 18, so that Claims 2-13 and 18 each now depend directly or indirectly from Claim 15. As discussed above, Claim 15 is not subject to any valid ground of rejection in view of the art of record, and Claim 15 is therefore believed to be in proper condition for allowance. Claims 2-13 and 18 are also believed to be patentably distinct from the art of record, for example for the same reasons as Claim 15.

Claims 21-24

The Office Action indicates that Claims 21-24 have been withdrawn from examination. However, for reasons discussed above, it is believed that Applicants are entitled to have the subject matter of Claims 21-24 examined on the merits. The foregoing amendments add limitations from original Claim 20 to each of Claims 21 and 22, so that Claims 21 and 22 are now independent claims. Claims 21 and 22 include limitations that are similar to limitations respectively appearing in Claims 15 and 17. Therefore, since the subject matter of Claims 15 and 17 is not subject to any valid rejection in view of the art of record, the subject matter of Claims 21 and 22 is also believed to be allowable, and notice to that effect is respectfully requested.

As discussed above, independent Claim 21 is believed to be allowable. Claims 23 and 24 each depend from independent Claim 21. Claims 23 and 24 are also believed to be allowable over the art of record, for example for the same reasons as Claim 21.

Claim 25

The Office Action indicates that Claim 25 has been withdrawn from examination on the

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

merits. However, for reasons discussed above, Claim 25 is technically not one of the non-elected claims, and it is respectfully submitted that Claim 25 should therefore have been examined on the merits. Claim 25 depends from Claim 21 which, as discussed above, is believed to be allowable. Claim 25 is also believed to be allowable over the art of record, for example for the same reasons as Claim 21.

Conclusion

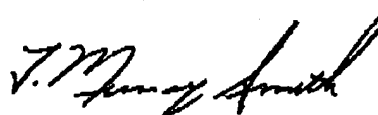
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Appl. No. 10/727,272
Reply to Office Action of August 8, 2005

Attorney Docket No. 2002-0945/24061.25
Customer No. 42717

Although Applicants believe that no fee is due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



T. Murray Smith
Registration No. 30,222
(972) 739-8647

Date: November 1, 2005

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephones: (972) 739-6900
Facsimile: (214) 200-0853
File: 24061.25

Enclosures: None

R-119620.1